

REMARKS/ARGUMENTS

A. AMENDMENTS TO THE CLAIMS

Claims 1-20 remain in this application. Claim 1 has been amended to correct an inconsistency in terminology (deleted “common” before the word “transaction” in line 5 to create an antecedent for the word transaction in line 6), to correct an obvious typographical errors (upper case usage in general and missing “and” in line 5), to assign the transaction identifier in line 5 to the at least one object (as in original claim 7). Claim 6 has been amended to make the claim a complete sentence. Claim 7 has been amended to correct minor typographical errors (upper case usage in general, missing punctuation and a missing “and” in line 8) and to delete the extra word “common” from line 9. For clarity, missing punctuation has been shown by deleting the word prior to the insertion point of the correct punctuation mark.

Claims 13-20 have been added by this amendment. Claims 13-20 are supported by the Application. No new matter has been added. For the reasons expressed below with respect to claims 1-12, claims 13-20 are allowable over the cited prior art.

B. CLAIM REJECTIONS

Claims 1-12 have been rejected by the examiner under 35 U.S.C. §102(e) as being anticipated by U.S. Patent 6,546, 385 issued to Mao et al. (herein, *Mao*).

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

1. Independent Claim 1

Claim 1 (as amended) recites the limitations of “Assigning a transaction identifier to the at least one object; and storing the at least one object with other objects having the same transaction identifier.” Claim 1, lines 5-7. In rejecting claim 1, the examiner found that Mao disclosed each of these limitations.

In particular, the examiner referred to call-out 103 of **Figure 1** as teaching the limitation “assigning a transaction identifier to the at least one object.” However, call-out 103 of **Figure 1**

of *Mao* refers only to "DOCUMENT DATA/TEXT/GRAPHICS." As illustrated in **Figure 1**, the DOCUMENT DATA/TEXT/GRAPHICS is fed to a document reader 104. No reference is made to assigning a "transaction identifier" to an object. **Figure 2** of *Mao* illustrates a process for generating a text index, encoding the text index, and storing the text index in non-volatile memory, but again no reference is made to creating and assigning a transaction index to either the encoded index or the read document. *Mao* simply does not teach this limitation of claim 1.

The examiner also cited to **Figure 1** of *Mao* as teaching the limitation "storing the at least one object with other objects having the same transaction identifier." There is no support in the *Mao* specification for this interpretation. Applicant's invention uses the term object broadly:

The electronic container - The second component of the system is a standardized electronic container Virtual Package ("Virpack"), which is an electronic file that may be used to store any type of object such as an image, document, database, or any computer generated file including word processing, database, EDI or any other type of file. It may also be construed to be a stand-alone workflow envelope or container. An important feature of a VirPack is that documents stored within the VirPack are retained in the original format in which they are created. Therefore, the recipient of a VirPack can manipulate an object contained within a VirPack using the same application (such as MS-Word) that the sender used to create the object. If the user so desires, applications may however, be created to convert documents into other formats such as converting a MS-Word document into an Adobe Acrobat (PDF file) prior to the document being added to the VirPack. Further, specific (unlimited) index information may be created and stored that is specifically associated with a particular object. Application, page 19, lines 11-23.

The object, be it an image, a document, a database, or other type of file is retained in the electronic container in format that it was created.

According to *Mao*, documents (or objects) are not permanently retained:

Once the document data, e.g., text and graphics, 103 is read by the index creation system 102, it is **temporarily stored** in a memory 108 to further process the document data 103 to create an index table therefrom. *Mao*, Col. 3, lines 55-58 (emphasis by bolding added).

What is stored is an index table created from the temporarily stored object:

The CPU 106 is also coupled to a two-dimensional bar code encoder 112 and to the non-volatile memory 120. The two-dimensional bar code encoder 112 creates a compressed version of the index tables in a two-dimensional bar code format which is

then stored in the non-volatile memory 120 in the encoded index tables portion thereof 130. *Mao*, Col. 3, lines 63-67, through Col.4, lines 1-4.

The non-volatile memory 120 does not include a storage register for related objects or indices.

Claim 1, both as originally claimed and in its amended form, recites limitations not in *Mao*. For this reason, claim 1 is not anticipated by *Mao*. Applicant submits that claim 1 is allowable over the cited prior art.

2. **Dependent Claims 2-6**

Dependent claims 2-6 depend from claim 1 and comprise all of the limitations of claim 1. As claim 1 recites limitations not disclosed in *Mao*, dependent claims 2-6 are not anticipated by *Mao*.

With respect to claim 4, the examiner cited Col. 2, lines 27-35 of *Mao* as teaching the limitation that the graphical code comprises routing information:

The present invention solves the aforementioned problems by providing a means that allows a person to feasibly perform much more exhaustive searching on hardcopy documents. Preferably, an index is compressed, encoded, and stored in a computer readable medium, and a computing device, such as a hand-held computing device, reads, decodes, and decompresses the information from the index and makes it available to a user of the device for searching the hardcopy document.

This disclosure does not describe "routing information" as that phrase is used in the application:

Routing information concerning where the document should go at various steps within the workflow of the organization and for example, where the document should be delivered upon return, can also all be contained within the unique barcode of the present invention.

Application, page 38, lines 17-20.

With respect to claim 6, the examiner cited Col. 2, lines 27-35 of *Mao* as disclosing that the binding of the at least one object to other objects:

In one preferred embodiment of the present invention, the compressed complete index, or nearly complete index, can be printed in a computer readable format such as a 2D bar code as part of a hardcopy book. A user of the computing device can extract

information from the index and use it to search the book. In a second embodiment, the full index or partial index information can be stored on the World Wide Web, and downloaded to a user's computing device, and used as above.

This disclosure does not describe binding the graphical code to "other objects." Rather, *Mao* describes creating a graphical code representing an index of a single document. By contrast, the application discloses a system and method for binding an object to any number of objects via a graphical code that comprises binding information:

It is yet another objective of the present invention to include within the machine-readable symbol, information that may be specific to group a set of related documents together. For example, the individual pages of a multi-page document, and related form sets, such as and not limited to mortgage, health care and legal documents. For example in the case of a mortgage document, a note, deed of trust, title policy amongst others may be related through common information shared in the machine readable symbol that is associated with each document within the set of documents.

Application, page 10, lines 4-10.

The additional limitations of Claim 6 are not, therefore, disclosed by *Mao*.

In view of the above arguments, Applicant respectfully submits that claims 2-6 are novel and not anticipated by the cited prior art.

3. **Independent Claim 7**

Original claim 7 was also rejected under 35 U.S.C. §102(e) as being anticipated by *Mao*. Claim 7, as amended, recites the limitations "an electronic record creator connected to the scanner for creating a composite electronic record comprising the at least one object and the graphical code; and a container creator for associating the at least one object with other objects and for assigning a transaction identifier to the at least one object." Claim 7 (as amended) lines 7-10. These limitations are not described expressly or inherently in *Mao*.

The examiner also cited column 4, lines 18-20 of *Mao* as teaching the limitation "creating a composite electronic record comprising the at least one object and the graphical code:"

Additionally, in the preferred embodiment, the printing system 140 prints the hard copy document data text and graphics 103 along with a hard copy representation of the two-dimensional bar code encoded index tables to create a complete indexed hard copy document.

This disclosure describes printing a *hard copy* of a document and a *hard copy* of a bar

code representation of an index table of that document. This disclosure does not describe creating a composite electronic record comprising the at least one object and the graphical code.

The examiner refers to non-volatile memory 120 illustrated in **Figure 1** of *Mao* as disclosing the limitation of “a container creator for associating the at least one object with other objects.” This is not the disclosed function of the non-volatile memory. According to *Mao*, documents (or objects) are not permanently retained:

Once the document data, e.g., text and graphics, 103 is read by the index creation system 102, it is **temporarily stored** in a memory 108 to further process the document data 103 to create an index table therefrom. *Mao*, Col. 3, lines 55-58.

What is stored is an index table created from the temporarily stored object:

The CPU 106 is also coupled to a two-dimensional bar code encoder 112 and to the non-volatile memory 120. The two-dimensional bar code encoder 112 creates a compressed version of the index tables in a two-dimensional bar code format which is then stored in the non-volatile memory 120 in the encoded index tables portion thereof 130. *Mao*, Col. 3, lines 63-67, through Col.4, lines 1-4.

The non-volatile memory 120 does not include a storage register for associating the at least one object with other objects.

The examiner refers to the 2-D bar encoder 112 illustrated in **Figure 1** of *Mao* as teaching the limitation “assigning a transaction identifier to the at least one object.” This is not the disclosed function of the 2-D bar encoder. As previously demonstrated, *Mao* does not disclose a “transaction identifier” being assigned to an object. **Figure 2** of *Mao* illustrates a process for generating a text index, encoding the text index, and storing the text index in non-volatile memory, but again no reference is made to creating and assigning a transaction index to either the encoded index or the read document. *Mao* simply does not teach this limitation of the application.

As claim 7, both as originally claimed and in its amended form, recites limitations not in *Mao*. For this reason, *Mao* does not anticipate claim 7.

4. **Dependent Claims 8-12**

Dependent claims 8-12 depend from claim 7 and comprise all of the limitations of claim

7 (as amended). As claim 7 recites limitations not disclosed in *Mao*, dependent claims 8-12 are not anticipated by *Mao*.

With respect to claim 11, the examiner referred to **Figure 4** of *Mao* as disclosing the container creator comprising instructions for viewing the at least one object, the unique index data, and supplemental data concerning the at least one object in a viewer. A relevant aspect of **Figure 4** of *Mao* is discussed at Col.7, lines 33-43:

A third alternative means of selecting query words for the searching assistant 402, i.e., for the exemplary embodiment including an OCR scanner and decoding software, allows the user to scan for a word from the hard copy document such as selected at Step 720. In such event, if the user desires to scan a word and makes the selection at Step 720, the searching assistant, at Step 722, scans a word from the hard copy document at Step 722 such as using the optical scanner 404 and the optical character recognition module 408 to provide the query word for the search function.

Neither this disclosure nor **Figure 4** describe “viewing the at least one object.” The apparatus illustrated in **Figure 4** is limited to displaying a search query and the results. There are no means for displaying the original object (e.g., a document).

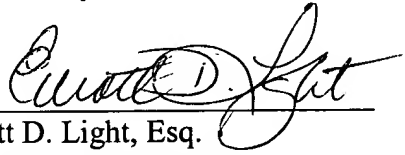
With respect to claim 12, the examiner referred to **Figure 4** of *Mao* as disclosing the container creator further comprising instructions for retrieving and manipulating the at least one object using the same application that created the at least one object. As noted with respect to claim 11, no means are provided to retrieve or manipulate an object in the application that created it.

In view of the above arguments, Applicant respectfully submits that claims 8-12 are novel and not anticipated by the cited prior art.

Appl. No. 09/533,152
Amendment Dated November 21, 2003
Response to Office Action dated September 16, 2003

As claims 1-20 are in allowable form, Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully Submitted,

By 
Elliott D. Light, Esq.
Registration No. 51,948
Roberts Abokhair & Mardula, LLC
11800 Sunrise Valley Drive, Suite 1000
Reston, VA 20191
703-391-2900